

## REMARKS

### I. General

The issues outstanding in the instant application are as follows:

- Claims 1-3 and 5-11 stand rejected under 35 U.S.C. 102(b) as anticipated by Schmid, U.S. Pat. No. 6,039,664 (hereinafter *Schmid*);
- Claims 12-14 and 16-22 stand rejected under 35 U.S.C. 102(b) as anticipated by Mutoh, German Pat. No. 3809169 (hereinafter *Mutoh*); and
- Claims 4 and 15 are indicated as allowable.

Applicant would again like to thank the Examiner for the indication of allowability of claims 4 and 15. However, Applicant respectfully traverses the outstanding rejections of the remaining claims, and requests reconsideration and withdrawal of the outstanding rejections in light of the remarks contained herein and the evidence presented in the declarations under 37 CFR § 1.132 filed earlier in this case. Claims 1-22 remain currently pending in this application.

### II. Declarations under 37 C.F.R. §1.132

In an Office Action dated June 6, 2005, the Examiner rejected claims 1-3 and 5-11 as anticipated by *Schmid*, and rejected claims 12-14 and 16-22 as anticipated by *Mutoh*. In that Office Action the Examiner asserted:

... it is an inherent feature that the parasitic torque would be balanced in the Schmid reference, and as such the applicant must provide evidence to the contrary (see MPEP 2112).

The Schmid reference teaches each of the limitations recited in the Claims, except for the parasitic torque. It is inherent that the torque loss would be balanced as in the claimed invention since the two inventions are almost identical in structure.

In response, Applicant filed declarations of the present Inventor and the sole Inventor of the *Schmid* reference wherein it is pointed out that the *Schmid* reference does not teach or suggest, nor does the *Schmid* reference necessarily possess the characteristic of balancing a pulley, strut attachment point and pivot bearing in terms of parasitic torque across the pivot

bearing. The Inventor's declaration also similarly address the rejections under *Mutoh*. As called for by 37 CFR 1.132, the declarations were presented as evidence to traverse the rejection. However, the present Office Action merely reiterates the above rejection, further quoting MPEP §2112.01. The present Office Action fails to even acknowledge entry of the declarations, much less address them as evidence rebutting the position that the cited art products necessarily possess the characteristics of the claimed product. Therefore, Applicant would respectfully request that the Examiner acknowledge entry of the declarations of the present Inventor and Mr. Schmid, and address the evidence presented therein, in a non-final Office Action, so that Applicant may have a full and fair opportunity to address any objections or rejections remaining following such consideration by the Examiner.

### **III. Rejections under 35 U.S.C. §102(e)**

In light of the above, Applicant respectfully reiterates the following arguments.

It is well settled that to anticipate a claim, a reference must teach every element of the claim, see M.P.E.P. §2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he elements must be arranged as required by the claim," see M.P.E.P. § 2131, citing *In re Bond*, 15 US.P.Q.2d 1566 (Fed. Cir. 1990). Furthermore, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim," see M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). Applicant again respectfully asserts that the rejections of record do not satisfy one or more of these requirements.

#### **A. Claims 1-3 and 5-11**

As noted above, claims 1-3 and 5-11 stand rejected as anticipated by *Schmid*. In the rejection of independent claim 1 the Office Action again parenthetically states:

It is inherent that the forces of the strut would balance out the forces of the pulley, because as the belt applies more force against the pulley the strut would apply an equal opposite force in order to keep tension on the belt. The forces of the pulley and the strut have to pass through the pivot bearing and balance in order to keep the appropriate tension on the belt (emphasis added).

As pointed out in M.P.E.P. § 2112(IV), to establish inherency "the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). M.P.E.P. § 2112.01(I) provides that "the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product." *In re Best*, 562 F.2d at 1255, 195 USPQ at 433.

Independent claim 1 recites "said pulley and said attachment point laterally offset in relation to said pivot bearing and substantially balanced in terms of parasitic torque across said pivot bearing" (emphasis added). Assuming *ad arguendo* that, as the Examiner alleges, That the forces of the pulley and the strut of *Schmid* "have to pass through the pivot bearing and balance in order to keep the appropriate tension on the belt," Applicant respectfully contends that *Schmid* does not teach a pulley and attachment point being substantially balanced in terms of parasitic torque across a pivot bearing as recited by claim 1. Although, the forces to keep tension on the belt in *Schmid* may pass through bolt 10 and accompanying axel (bearing) 6 to engine block 4, nothing in *Schmid* would suggest that the pulley and attachment point are substantially balanced in terms of parasitic torque across axel 6.

Further, Applicant advances the earlier presented Declarations under 37 C.F.R. §1.132 as rebuttal evidence under M.P.E.P. § 2112.01(I). Therein, the present Inventor and the Inventor of the *Schmid* reference point out that one of ordinary skill in the art would not find that the tensioner arrangement of *Schmid* would necessarily possess the characteristic of being substantially balanced in terms of parasitic torque across its pivot bearing(s). More specifically, *Schmid* fails to teach or suggest balancing a pulley, attachment point and pivot bearing in terms of parasitic torque across the pivot bearing by arranging the a pulley, attachment point and pivot bearing such that a balance line that might be inferred as passing through the through an axis of the strut attachment point and a center of the tensioner pulley would intersect the pivot shaft, much less intersect the pivot shaft within a lateral limit of the pivot bearing(s). Such an implementation of the invention of claim 1 is taught as a means to balance the a pulley, strut attachment point and pivot bearing in terms of parasitic torque by the specification of patent application serial number 10/664,443. Review of Figure 1 of *Schmid*

makes clear that a balance line cannot pass through the axis of the strut attachment point, a center of the tensioner pulley and the pivot shaft of *Schmid*, as the a plane containing the pulley axis and the pivot axis is perpendicular to a plane containing the pivot axis and the attachment point. As pointed out in the background section of the specification of present patent application, the attachment point for the strut of *Schmid* remains substantially in the plane at the center of rotation of the pivot bearing. It is readily apparent that, when the tensioner of *Schmid* is placed into operation, the forces acting upon the tensioner by the belt and the strut give rise to an unbalanced load across the pivot bearing causing parasitic torque, which tends to force the pivot shaft to axially misalign with the bearing. This would be true whether the strut is providing the biasing force for the tensioner or only modifying the biasing force through damping. Thus, *Schmid* fails to teach or suggest, nor does *Schmid* necessarily possess the characteristic of balancing a pulley, strut attachment point and pivot bearing in terms of parasitic torque across the pivot bearing.

For at least the foregoing reasons, Applicant again respectfully asserts that *Schmid* fails to teach at least "said pulley and said attachment point ... substantially balanced in terms of parasitic torque across said pivot bearing," as recited by independent claim 1. Therefore, independent claim 1 is patentable over the 35 U.S.C. § 102 rejection of record. Furthermore, there are great differences between the claim 1 and the prior art of record, and a person of ordinary skill in the art considering the prior art would not find these differences obvious. For example, *Schmid* is silent concerning parasitic torque, much less substantially balancing a pulley and attachment in terms of parasitic torque across a pivot bearing.

Claims 2, 3 and 5-11 ultimately depend from base independent claim 1, and thereby, each of dependent claims 2, 3 and 5-11 inherit all elements of independent claim 1. Therefore, each of claims 2, 3 and 5-11 set forth features and limitations not recited by *Schmid*. Thus, Applicant respectfully asserts that for at least the reasons advanced above in addressing the anticipation rejection of independent claim 1, claims 2, 3 and 5-11 are also patentable over the 35 U.S.C. § 102 rejections of record.

**B. Claims 12-14 and 16-21**

As also noted above, claims 12-14 and 16-21 stand rejected as anticipated by *Mutoh*. In the rejection of independent claims 12 the Office Action again parenthetically states:

It is inherent that the forces of the strut would balance out the forces of the pulley, because as the belt applies more force against the pulley the strut would apply an equal opposite force in order to keep tension on the belt. The forces of the pulley and the strut have to pass through the pivot bearing and balance in order to keep the appropriate tension on the belt (emphasis added).

As pointed out above, to establish inherency "the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art" and that "the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product."

Independent claim 12 recites "said pulley and said attachment point laterally offset in relation to said pivot bearing and substantially balanced in terms of parasitic torque across said pivot bearing" (emphasis added). Assuming *ad arguendo* that, as the Examiner alleges, that the forces of the pulley and the strut of *Mutoh* "have to pass through the pivot bearing and balance in order to keep the appropriate tension on the belt," Applicant respectfully contends that *Mutoh* does not teach a pulley and attachment point being substantially balanced in terms of parasitic torque across a pivot bearing as recited by claim 12. Although, one might view the forces to keep tension on the belt in *Mutoh* as passing through bolt 10 and what may be an accompanying (unnumbered) bearing to the engine block, nothing in *Mutoh* would suggest that the pulley and attachment point are substantially balanced in terms of parasitic torque across the alleged unnumbered bearing.

Further, Applicant presents the Declaration under 37 C.F.R. §1.132 of the present Inventor as rebuttal evidence under M.P.E.P. § 2112.01(I). Therein, beginning on page 4, the Inventor points out:

one of ordinary skill in the art would not find that the tensioner arrangement of *Mutoh* would necessarily possess the characteristic of being substantially balanced in terms of parasitic torque across its pivot



bearing(s), nor would these characteristics necessarily flow from the teachings of *Mutoh*. More specifically, *Mutoh* fails to teach or suggest balancing a pulley, attachment point and pivot bearing in terms of parasitic torque across the pivot bearing by arranging the a pulley, attachment point and pivot bearing such that a balance line that might be inferred as passing through an axis of the strut contact point of *Mutoh* and a center of the tensioner pulley would intersect the pivot shaft, much less intersect the pivot shaft within a lateral limit of the pivot bearing(s). See Figure 2 of *Mutoh*. Review of Figure 2 of *Mutoh* makes clear that a balance line cannot pass through the axis of the strut attachment point, a center of the tensioner pulley and the pivot shaft of *Mutoh*, as the a plane containing the pulley axis and the pivot axis is perpendicular to a plane containing the pivot axis and the attachment point. Thus, *Mutoh* fails to teach or suggest balancing a pulley, strut attachment point and pivot bearing in terms of parasitic torque across the pivot bearing. Nor are these characteristics necessarily possessed by *Mutoh* or do they necessarily flow from the teachings of *Mutoh*.

Thus, *Mutoh* fails to teach at least "said pulley and said attachment point laterally offset in relation to said pivot bearing and substantially balanced in terms of parasitic torque across said pivot bearing," as recited by independent claim 12. Further, as alluded to above, *Mutoh* fails to explicitly disclose a pivot bearing as explicitly recited by claim 12. Thus, *Mutoh* fails to teach at least this element of claim 12 in as complete detail as recited in the claim.

For at least the above reasons, Applicant respectfully asserts that independent claim 12 is patentable over the 35 U.S.C. § 102 rejection of record. Furthermore, there are great differences between the claims and the prior art of record, and a person of ordinary skill in the art considering the prior art would not find these differences obvious. For example, *Mutoh* is silent concerning parasitic torque and a pivot bearing, much less substantially balancing a pulley and attachment in terms of parasitic torque across such a pivot bearing.

Claims 13, 14 and 16-21 ultimately depend from base independent claim 12, and thereby, each of dependent claims 13, 14 and 16-21 inherit all elements of independent claim 12. Therefore, each of claims 13, 14 and 16-21 set forth features and limitations not recited by *Mutoh*. Thus, Applicant respectfully asserts that for at least the reasons advanced above in addressing the anticipation rejection of independent claim 12, claims 13, 14 and 16-21 are also patentable over the 35 U.S.C. § 102 rejections of record.

### C. Claim 22

As noted, independent claim 22 stands rejected as anticipated by *Mutoh*. However, independent method claim 22 recites:

communicating a biasing force from said strut to said attachment point,  
said supporting structure communicating said biasing force to said pulley through rotation about said pivot bearing, and  
substantially balancing said biasing force at said pivot bearing in terms of parasitic torque."

The Office Action relies on the same inherency arguments as advanced in addressing claim 12 to reject claim 22 as anticipated by *Mutoh*, namely that "[t]he forces of the pulley and the strut have to pass through the pivot bearing and balance in order to keep the appropriate tension on the belt" (emphasis added). However, as pointed out above, assuming *ad arguendo* that, that the forces of the pulley and the strut of *Mutoh* "have to pass through the pivot bearing and balance in order to keep the appropriate tension on the belt," *Mutoh* still does not teach (or suggest) "substantially balancing said biasing force at said pivot bearing in terms of parasitic torque" (emphasis added). As also discussed above, one might view the forces to keep tension on the belt in *Mutoh* as passing through bolt 10 and what may be an accompanying (unnumbered) bearing to the engine block; however, nothing in *Mutoh* would suggest that the pulley and attachment point are substantially balanced in terms of parasitic torque particularly as *Mutoh* fails to explicitly disclose a pivot bearing, much less discuss mitigating the effects of parasitic torque across such a bearing.

Further, Applicant again presents the Declaration under 37 C.F.R. §1.132 of the present Inventor as rebuttal evidence under M.P.E.P. § 2112.01(I). Therein, beginning on page 4, the Inventor points out:

one of ordinary skill in the art would not find that the tensioner arrangement of *Mutoh* would necessarily possess the characteristic of being substantially balanced in terms of parasitic torque across its pivot bearing(s), nor would these characteristics necessarily flow from the teachings of *Muto*. More specifically, *Mutoh* fails to teach or suggest balancing a pulley, attachment point and pivot bearing in terms of parasitic torque across the pivot bearing by arranging the a pulley,

attachment point and pivot bearing such that a balance line that might be inferred as passing through an axis of the strut contact point of *Mutoh* and a center of the tensioner pulley would intersect the pivot shaft, much less intersect the pivot shaft within a lateral limit of the pivot bearing(s). See Figure 2 of *Mutoh*. Review of Figure 2 of *Mutoh* makes clear that a balance line cannot pass through the axis of the strut attachment point, a center of the tensioner pulley and the pivot shaft of *Mutoh*, as the a plane containing the pulley axis and the pivot axis is perpendicular to a plane containing the pivot axis and the attachment point. Thus, *Mutoh* fails to teach or suggest balancing a pulley, strut attachment point and pivot bearing in terms of parasitic torque across the pivot bearing. Nor are these characteristics necessarily possessed by *Mutoh* or do they necessarily flow from the teachings of *Mutoh*.

Thus, Applicant respectfully asserts that *Mutoh* fails to teach at least "substantially balancing said biasing force at said pivot bearing in terms of parasitic torque," as recited by claim 22. Further, *Mutoh* fails to explicitly disclose a pivot bearing as explicitly recited by claim 22. Thus, *Mutoh* fails to teach at least this element of claim 22 in as complete detail as recited in the claim.

For at least the above reasons, Applicant respectfully asserts that independent claim 22 is patentable over the 35 U.S.C. § 102 rejection of record. Furthermore, there are great differences between the claims and the prior art of record, and a person of ordinary skill in the art considering the prior art would not find these differences obvious. For example, *Mutoh* is silent concerning parasitic torque and a pivot bearing, much less substantially balancing said biasing force at said pivot bearing in terms of parasitic torque.

#### IV. Conclusion

For the reasons given above, particularly as reinforced by the previously filed Declarations under 37 C.F.R. § 1.132 of the present Inventor, Alexander Serkh, and the Inventor of the *Schmid* reference Michael B. Schmid, Applicant submits that the pending claims distinguish over the prior art of record under 35 U.S.C. § 102 and § 103. Accordingly, Applicant asserts that this application is in condition for full allowance.



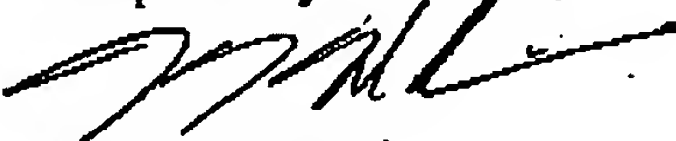
This response is accompanied by a one-month petition for extension of time. The fees for the extension of time are dealt with in the petition. Applicant believes no further fees are required. However, if a further fee is due, please charge Deposit Account No. 07-0475, from which the undersigned is authorized to draw.

Applicant respectfully requests that the Examiner call the below listed attorney if the Examiner believes that the attorney can help in resolving any remaining issues or can otherwise be helpful in expediting prosecution of the present application.

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Respectfully submitted,



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